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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,700	01/24/2000	Bernard Conrad	61130/JPW/KRD	7519

7590

04/24/2003

Ivor R. Elrifi
Mintz Levin
One Financial Center
Boston, MA 02111

EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 04/24/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,700

Applicant(s)

CONRAD ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002 and 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-66 and 68-79 is/are pending in the application.
- 4a) Of the above claim(s) 70-72 and 74-76 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 62, 73, 78 and 79 is/are allowed.
- 6) ☒ Claim(s) 63-66, 68, 69, 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Claims 62-66, and 68-79 are pending and claims 70-72, and 74-76 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claims 62-66, 68, 69, 73, and 77-79 are examined on merits.

Oath/Declaration

Objection of the Declaration is withdrawn because the Declaration filed on 3-13-2000 (Paper No. 3) was executed in accordance with 37 CFR 1.68.

Claim Rejections - 35 USC § 112

Claim **66 remains rejected** for reason of record under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had **possession** of the claimed invention. Applicant argues that the claim amendment would obviate this rejection but the instant claim is drawn to naturally occurring allelic variants that the specification does not describe.

Any rejection not repeated is withdrawn.

NEW GROUNDS OF REJECTION

63-66,

Claim Objections

Claims 68 and 69 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The base claim is drawn to polypeptide comprising SEQ ID NO: 36 and the instant claims are drawn to fragment thereof.
+ variants

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 63-65 recite the limitation "the variant" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 63 and 64 are confusing therefore indefinite because they refer to (b) and/or (a) of the base claim. However such limitations do not exist in the base claim.

Claim 77 is confusing because it is not clear what kinds of product(s) is claimed by the instant claim. The specification says that SEQ ID NO:38 at position 154 is stop signal, which indicates SEQ ID NO:38 might be two proteins instead of an isolated polypeptide as indicated. See the enablement rejection below.

Claim 77 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to **enable** one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claim is drawn to SEQ ID NO:38. The specification at page 49 (Fig. 7F legend) says that amino acid #154 of SEQ ID NO:38 is Z (stop signal). A stop codon in mRNA does not have corresponding an amino acid as a physical entity. If a stop codon is at position 154 of protein-encoding mRNA, then the translation stops at that point and do not proceed further. The specification does not teach how to make the protein comprising SEQ ID NO:38. Note Z is not a physical entity therefore translation cannot occur jumping Z and then Alanine... so forth as shown in Fig. 7F.

Allowable Subject Matter

Claims 62, 73, 78, and 79 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-

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308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu
April 23, 2003


**MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800**

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